

I. REAL PARTY IN INTEREST	1
II. RELATED APPEALS AND INTERFERENCES	1
III. STATUS OF CLAIMS.....	2
IV. STATUS OF AMENDMENTS.....	2
V. SUMMARY OF CLAIMED SUBJECT MATTER.....	2
VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL.....	3
VII. ARGUMENT.....	3
VIII. CLAIMS APPENDIX	9
IX. EVIDENCE APPENDIX	15
X. RELATED PROCEEDINGS APPENDIX	16

**NOTICE OF APPEAL FROM THE EXAMINER TO
THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of	:	Customer Number: 29973
	:	
Thomas DISTEFANO, III	:	Confirmation Number: 9812
	:	
Application No.: 09/405,731	:	Group Art Unit: 3692
	:	
Filed: September 24, 1999	:	Examiner: C. Graham
	:	
For:		MODERATING EXTERNAL ACCESS TO AN ELECTRONIC DOCUMENT AND AUTHORING DEVELOPMENT AND DISTRIBUTION SYSTEM

APPEAL BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Appeal Brief is submitted in support of the Notice of Appeal filed June 19, 2007,
wherein Appellant appeals from the Examiner's rejection of claims 1-20.

I. REAL PARTY IN INTEREST

The real party in interest is Thomas DiStefano.

II. RELATED APPEALS AND INTERFERENCES

Appellant is unaware of any related appeals and interferences.

III. STATUS OF CLAIMS

Claims 1-20 are pending and six-times rejected in this Application. It is from the multiple rejections of claims 1-20 that this Appeal is taken.

IV. STATUS OF AMENDMENTS

The claims have not been amended subsequent to the imposition of the Sixth Office Action dated December 19, 2006 (hereinafter the Sixth Office Action).

V. SUMMARY OF CLAIMED SUBJECT MATTER

Referring to Figure 1 and 2A and independent claims 1 and 11, a computer apparatus and method for moderating external access to an electronic document authoring, development and distribution system 4 is disclosed (page 9, lines 3-11 of Appellant's disclosure). The computer apparatus includes identifying means 50, permitting means 62, and elimination means 68, 70, 72. The identifying means 50 identifies a third party 1 requesting access to the electronic document authoring, development and distribution system 4 (page 10, lines 27-28). The permitting means 62 permits restricted access to the third party 1 to selected functions of the electronic document authoring, development and distribution system 4 (page 11, lines 19-27). The eliminating means eliminates 68, 70, 72 (page 12, lines 4-8) all access restrictions 56, 58, 60 (page 11, lines 9-18) to the selected functions in the electronic document authoring, development and distribution system 4 which were imposed in the permitting step 62 when the third party 1 registers 66 as a registered user of the authoring, development and distribution system 4 (page 12, lines 3-4).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

1. Claims 1 and 11 are rejected under 35 U.S.C. § 102 for anticipation based Bernardo et al., U.S. Patent No. 6,308,188 (hereinafter Bernardo); and
2. Claims 2-10 and 12-20 are rejected under 35 U.S.C. § 103 for obviousness based upon Bernardo in view Perkowski, U.S. Patent No. 6,625,581.

VII. ARGUMENT

THE REJECTION OF CLAIMS 1 AND 11 UNDER 35 U.S.C. § 102 FOR ANTICIPATION BASED UPON BERNARDO

For convenience of the Honorable Board in addressing the rejections, claim 11 stands or falls together with independent claim 1.

The Examiner's analysis in rejecting claim 1 is found on page 2 of the Office Action. Although the Examiner's analysis covered 18 lines of text, the Examiner could have easily been rewritten as follows:

Claim 1 is rejected based upon the Abstract; column 2 lines 40-65; column 3 lines 17-42; column 4 lines 49-67; column 5-15, lines 1-67; column 18 lines 3-45; and column 21, lines 1-48 of Bernardo (the "third party," as claimed, is disclosed by "users" in Bernardo).

As an aside, the entirety of Bernardo's specification covers 23 ½ columns (including the claims) and the Examiner cited, not counting the Abstract, approximately 13 columns of text in Bernardo, for nearly each of the passages in claim 1.

The factual determination of anticipation under 35 U.S.C. § 102 requires the identical disclosure, either explicitly or inherently, of each element of a claimed invention in a single reference.¹ Moreover, the anticipating prior art reference must describe the recited invention with sufficient clarity and detail to establish that the claimed limitations existed in the prior art and that such existence would be recognized by one having ordinary skill in the art.² As part of this analysis, the Examiner must (a) identify the elements of the claims, (b) determine the meaning of the elements in light of the specification and prosecution history, and (c) identify corresponding elements disclosed in the allegedly anticipating reference.³ This burden has not been met.

As noted by the Supreme Court in Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.,⁴ a clear and complete prosecution file record is important in that "[p]rosecution history estoppel requires that the claims of a patent be interpreted in light of the proceedings in the PTO during the application process." The Courts that are in a position to review the rejections set forth by the Examiner (i.e., the Board of Patent Appeals and Interferences, the Federal Circuit, and the Supreme Court) can only review what has been written in the record; and therefore, the Examiner must clearly set forth the rationale for the rejection and clearly and particularly point out those elements within the applied prior art being relied upon by the Examiner in the statement of the rejection. The Examiner, however, beyond asserting that the claimed "third party" is disclosed by the users in Bernardo, has not set forth any analysis whatsoever.

¹ In re Rijckaert, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); Perkin-Elmer Corp. v. Computervision Corp., 732 F.2d 888, 894, 221 USPQ 669, 673 (Fed. Cir. 1984).

² See In re Spada, 911 F.2d 705, 708, 15 USPQ 1655, 1657 (Fed. Cir. 1990); Diversitech Corp. v. Century Steps, Inc., 850 F.2d 675, 678, 7 USPQ2d 1315, 1317 (Fed. Cir. 1988).

³ Lindermann Maschinenfabrik GMBH v. American Hoist & Derrick Co., 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984).

⁴ 535 U.S. 722, 122 S.Ct. 1831, 1838, 62 USPQ2d 1705, 1710 (2002).

This requirement that the Examiner clearly set forth the rationale for the rejection and clearly and particularly point out those elements within the applied prior art being relied upon by the Examiner in the statement of the rejection is found in with 37 C.F.R. § 1.104(c), which reads:

In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

Moreover, in the unpublished opinion of Ex parte Pryor⁵, the Board of Patent Appeals and Interferences recognized the necessity for an Examiner to supply sufficient information to establish a prima facie case of anticipation. Specifically, the Board wrote:

At the outset, we note the examiner has been of little help in particularly explaining the rejections on appeal. A mere statement that claims stand rejected "as being clearly anticipated by" a particular reference, without any further rationale, such as pointing out corresponding elements between the instant claims and the applied reference, fails to clearly make out a prima facie case of anticipation. (emphasis in original)

Despite the very specific requirement for the Examiner to clearly set forth the rationale for the rejection and clearly and particularly point out those elements within the applied prior art being relied upon by the Examiner, the Examiner has failed to do so. Instead, the Examiner's statement of the rejection simply consists of the Examiner repeating, almost word-for-word, certain claimed passages and asserting that these certain claimed passages are disclosed by certain specified passages within Bernardo constituting at least 12 columns of text, in total, for each claimed passage. The manner in which the Examiner conveyed the statement of the rejection, however, has not "designated as nearly as practicable" the particular parts in Bernardo being relied upon in the rejection.

⁵ Appeal No. 1997-2981.

It is practicable for the Examiner, for each of the claimed elements, to specifically identify each feature within Bernardo being relied upon to teach each of the particular claimed elements. For example, the Examiner can "specifically identify" a feature, corresponding to the claimed element, within the applied prior art by identifying a reference numeral associated with the feature. In addition to or alternatively, the Examiner may cite to a brief passage (i.e., 1 or 2 lines or even a portion of a line) within the applied prior art that identifies the feature that corresponds to the claimed element. However, citing 12 columns of text to disclose a single (or multiple) claimed elements does not designate "as nearly as practicable," the particular features within Bernardo being relied upon by the Examiner in the rejection.

The importance of the specificity requirement of 37 C.F.R. § 1.104(c) are also further evident in M.P.E.P. § 706.07, which states:

The examiner should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be developed, if possible, before appeal.

A clear issue, however, cannot be developed between Appellant and the Examiner where the basis for the Examiner's rejection of the claims is ambiguous. The Examiner's "analysis" provides little insight as to (i) how the Examiner is interpreting the elements of the claims and (ii) what specific features within Bernardo the Examiner believes identically discloses the specific elements (and interactions between elements) recited in the claims. By failing to specifically identify those features within Bernardo being relied upon in the rejection, the Examiner has essentially forced Appellant to engage in mind reading and/or guessing to determine how the Examiner is interpreting the elements of the claims and what specific features within Bernardo the Examiner believes identically disclose the claimed invention.

Appellant, therefore, respectfully submit that the Examiner has not met the burden in establishing a prima facie case of anticipation. Specifically, the Examiner has failed to specifically identify, within Bernardo, the following claimed features: (i) an electronic document authoring, development and distribution system; (ii) a third party requesting access to the electronic document authoring, development and distribution system; (iii) an identification of the third party requesting access to the electronic document authoring, development and distribution system; (iv) restricted access; (v) selected functions of the electronic document authoring, development and distribution system; (vi) restricted access to the third party to selected functions of the electronic document authoring, development and distribution system being permitted; (vii) all access restrictions imposed in the permitting step; (viii) the third party registering as a user of the document authoring, development and distribution system; (xi) all of the access restrictions being eliminated; and (x) all of the access restrictions being eliminated upon the third party registering. Not only has the Examiner failed to specifically identify, within Bernardo, the above-identified claimed limitations, the Examiner has failed to set forth a claim construction for any of these claimed limitations. Thus, the Examiner has failed to establish a prima facie case of anticipation. Appellant, therefore, respectfully submits that the imposed rejection of claims 1 and 11 under 35 U.S.C. § 102 for anticipation based upon Bernardo is not viable.

**THE REJECTION OF CLAIMS 2-10 AND 12-20 UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS
BASED UPON BERNARDO IN VIEW OF PERKOWSKI**

For convenience of the Honorable Board in addressing the rejections, claims 2-10 and 12-20 stand or fall together with independent claim 1.

Claims 2-10 and 12-20 respectively depend from independent claims 1 and 11, and Appellant incorporates herein the arguments previously advanced in traversing the imposed rejection of claims 1 and 11 under 35 U.S.C. § 102 for anticipation based upon Bernardo. The secondary reference to Perkowski does not cure the argued deficiencies of Bernardo. Accordingly, the proposed combination of references would not yield the claimed invention. Appellant, therefore, respectfully submits that the imposed rejection of claims 2-10 and 12-20 under 35 U.S.C. § 103 for obviousness based upon Bernardo in view of Perkowski is not viable.

Conclusion

Based upon the foregoing, Appellant respectfully submits that the Examiner's rejections under 35 U.S.C. §§ 102, 103 are not viable. Appellant, therefore, respectfully solicits the Honorable Board to reverse the Examiner's rejection under 35 U.S.C. §§ 102, 103.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due under 37 C.F.R. §§ 1.17, 41.20, and in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

Date: August 20, 2007

Respectfully submitted,

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CUSTOMER NUMBER 29973

VIII. CLAIMS APPENDIX

1. A method for moderating external access to an electronic document authoring, development and distribution system comprising the steps of:

identifying a third party requesting access to said electronic document authoring, development and distribution system;

permitting restricted access to said third party to selected functions of said electronic document authoring, development and distribution system; and,

eliminating all access restrictions to said selected functions in said electronic document authoring, development and distribution system which were imposed in said permitting step when said third party registers as a registered user of said authoring, development and distribution system.

2. The method according to claim 1, wherein said permitting step comprises the steps of:

first disabling in said system all document saving functionality;

second disabling in said system all document copying functionality;

third disabling in said system all document downloading functionality; and,

permitting access to said system subsequent to said first, second and third disabling steps.

3. The method according to claim 1, wherein said eliminating step comprises the steps of:

accepting payment from said third party;

recognizing said third party as a registered user; and,

removing access restrictions to said system imposed on said registered third party by said permitting step.

4. The method according to claim 3, wherein said accepting step comprises the steps of:
accepting credit-card information from said third party;
submitting said credit card information to a corresponding credit card authorization system; and,
retrieving payment authorization from said authorization system.

5. The method according to claim 3, wherein said removing step comprises the steps of:
first enabling in said system all document saving functionality;
second enabling in said system all document copying functionality;
third enabling in said system all document downloading functionality; and,
permitting access to said system subsequent to said first, second and third enabling steps.

6. The method according to claim 3, further comprising the steps of:
accepting a request from said registered user for a unique URL; registering said unique URL on behalf of said registered user; and, associating said unique URL with a Web site commissioned by said registered user and posted for Internet viewing said system.

7. The method according to claim 3, further comprising the steps of:
accepting a request from said registered user to submit a URL associated with a Web site commissioned by said registered user to a plurality of Web search engines;

retrieving a list of said Web search engines selected by said registered user; and,
submitting said URL to each Web search engine contained in said list.

8. The method according to claim 1, further comprising the steps of:
accepting electronic submissions of Web assets from said third party;
storing said accepted Web assets in a Web asset database; and,
compensating said third party for subsequent distribution of said Web assets.

9. The method according to claim 8, wherein said accepting step comprises the steps of:
permitting an upload of said Web assets from said third party;
screening said uploaded Web assets for marketable content; and,
accepting said screened uploaded Web assets for distribution on said system.

10. The method according to claim 8, wherein said compensating step comprises the steps of:

for each Web asset used by a registered user in forming a Web page, identifying a third party author corresponding to said Web asset; and,

crediting a credit card account of said third party author in compensation for said use by said registered user of said Web asset corresponding to said third party author.

11. A computer apparatus programmed with a routine set of instructions stored in a fixed medium, said computer apparatus comprising:

means for identifying a third party requesting access to an electronic document authoring, development and distribution system;

means for permitting restricted access to said third party to selected functions of said electronic document authoring, development and distribution system; and,

means for eliminating all access restrictions to said selected functions in said electronic document authoring, development and distribution system which were imposed in said permitting step when said third party registers as a registered user of said authoring, development and distribution system.

12. The computer apparatus according to claim 1, wherein said permitting step comprises the steps of:

first means for disabling in said system all document saving functionality;

second means for disabling in said system all document copying functionality;

third means for disabling in said system all document downloading functionality; and,

means for permitting access to said system subsequent to said first, second and third disabling by said first, second, and third disabling means.

13. The computer apparatus according to claim 11, wherein said eliminating step comprises the steps of:

means for accepting payment from said third party;

means for recognizing said third party as a registered user; and,

means for removing access restrictions to said system imposed on said registered third party by said permitting means.

14. The computer apparatus according to claim 13, wherein said accepting step comprises the steps of:

means for accepting credit-card information from said third party;

means for submitting said credit card information to a corresponding credit card authorization system; and,

means for retrieving payment authorization from said authorization system.

15. The computer apparatus according to claim 13, wherein said removing step comprises the steps of:

first means for enabling in said system all document saving functionality;

second means for enabling in said system all document copying functionality;

third means for enabling in said system all document downloading functionality; and,

permitting access to said system subsequent to said first, second and third enabling steps by said first, second, and third enabling means.

16. The computer apparatus according to claim 13, further comprising the steps of:

accepting a request from said registered user for a unique URL; registering said unique URL on behalf of said registered user; and, associating said unique URL with a Web site commissioned by said registered user and posted for Internet viewing said system.

17. The computer apparatus according to claim 13, further comprising the steps of:

means for accepting a request from said registered user to submit a URL associated with a Web site commissioned by said registered user to a plurality of Web search engines;

means for retrieving a list of said Web search engines selected by said registered user; and,

means for submitting said URL to each Web search engine contained in said list.

18. The computer apparatus according to claim 11, further comprising the steps of:

means for accepting electronic submissions of Web assets from said third party;

means for storing said accepted Web assets in a Web asset database; and,

means for compensating said third party for subsequent distribution of said Web assets.

19. The computer apparatus according to claim 18, wherein said accepting step comprises the steps of:

means for permitting an upload of said Web assets from said third party;

means for screening said uploaded Web assets for marketable content; and,

means for accepting said screened uploaded Web assets for distribution on said system.

20. The computer apparatus according to claim 18, wherein said compensating step comprises the steps of:

for each Web asset used by a registered user in forming a Web page, means for identifying a third party author corresponding to said Web asset; and,

means for crediting a credit card account of said third party author in compensation for said use by said registered user of said Web asset corresponding to said third party author.

IX. EVIDENCE APPENDIX

No evidence submitted pursuant to 37 C.F.R. §§ 1.130, 1.131, or 1.132 of this title or of any other evidence entered by the Examiner has been relied upon by Appellant in this Appeal, and thus no evidence is attached hereto.

X. RELATED PROCEEDINGS APPENDIX

Since Appellant is unaware of any related appeals and interferences, no decision rendered by a court or the Board is attached hereto.